

### ***Remarks***

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, independent claims 14 and 16 are pending in the application. Claims 3, 9, 11-13, 15 and 17 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. Claims 14 and 16 have been amended to remove reference to "the demethylation inhibitor (DMI) fungicide" and "the DMI fungicide," respectively, and to add the phrase "subject to attack by phytopathogenic fungi." Support for this amendment can be found, *e.g.*, at page 17, lines 1-9 and Example 1 on page 18 of the English language translation of the application as filed. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

### ***Objections to the Claims***

Claim 9 was objected to as containing the term "DMI" as opposed to the full name of demethylation inhibitor." *See* Office Action at page 3. By the foregoing amendment, claim 9 has been cancelled. Thus, the objection to claim 9 is moot.

### ***Rejections under 35 U.S.C. § 112***

Claim 9 was rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite for containing the phrase "the DMI fungicide fluquinconazole." *See* Office Action at page 4. By the foregoing amendment, claim 9 has been cancelled. Thus, the

rejection of claim 9 is moot. Applicants note that claims 14 and 16 contain the phrases "the demethylation inhibitor (DMI) fungicide" and "the DMI fungicide," respectively. By the foregoing amendment, each of claims 14 and 16 has been amended to recite "fluquinconazole."

***Rejections under 35 U.S.C. §§ 102 and 103***

***Rejections in view of Asrar et al.***

Each of claims 3, 9 and 11 were rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 7,098,170 B2 ("Asrar *et al.*"). See Office Action at page 5. According to the Examiner, "Asrar *et al.* disclose all the limitation of the instant claims wherein soybean and seed are treated with fluquinconazole alone and/or in combination with azoxystrobin which inherently protects the soybean from soybean rust." Office Action at page 5. The cancellation of claims 3, 9 and 11 herein renders this rejection moot.

***Asrar et al. in view of Amerman et al. and Suarez-Cervieri et al.***

Each of claims 3, 9 and 11-17 were rejected under 35 U.S.C. § 103(a) as obvious over Asrar *et al.* in view of U.S. Publ. Appl. No. 2005/0165076 A1 (Ammerman *et al.*) and U.S. Publ. Appl. No. 2005/0032903 (Suarez-Cervieri *et al.*). See Office Action at pages 7-10. Applicants respectfully traverse this rejection as it pertains to the current claims.

The cancellation of claims 3, 9, 11-13, 15 and 17 herein renders the rejection for claims 3, 9, 11-13, 15 and 17 moot. With respect to claims 14 and 16, Applicants respond as follows.

The current claims are directed to a method of protecting soya bean plants subject to attack by phytopathogenic fungi against soya bean rust, consisting essentially of applying fluquinconazole to the seed of said plants to protect said plants from subsequent attack by phytopathogenic fungi. In making the rejection based on Asrar *et al.* in view of Ammerman *et al.* and Suarez-Cervieri *et al.*, the Examiner relies firstly upon the erroneous position that "Asrar *et al.* teach treating soybean and seed using fluquinconazole alone and/or in combination with azoxystrobin which would inherently protect the soybean from soybean rust." However, as set forth below, the rejection is improper in light of the holding of *Ex parte Zbornik and Peterson*, 109 U.S.P.Q. 508, 509 (BPAI 1956).

The current claims are directed to a method of protecting soya bean plants subject to attack by phytopathogenic fungi against soya bean rust, comprising applying fluquinconazole to the seed of said plants to protect said plants from subsequent attack by phytopathogenic fungi. In contrast, as discussed in detail in Applicants' Amendment and Reply of October 16, 2008, Asrar *et al.* does not disclose soy bean rust, or even the *Phakospora* fungal species known to cause soybean rust. Moreover, Asrar *et al.* does not disclose protecting soy bean plants susceptible to subsequent attack by phytopathogenic fungi. Rather, the disclosure of Asrar *et al.* is directed to a "method of increasing the vigor and/or the yield of an agronomic plant comprising treating the plant or its propagation material with an effective amount of an active agent which has the capability of increasing the yield and/or vigor of the plant *in the absence of pest pressure by fungal plant pathogens*, where the active agent is selected from the group consisting of a

diazole fungicide, a triazole fungicide, and a strobilurin-type fungicide." Asrar *et al.*, col. 2, lines 44-51 (emphasis added).

It is settled law that for process/method claims, "the 'material acted upon' must be given weight." *See Ex parte Zbornik and Peterson*, 109 U.S.P.Q. 508, 509 (BPAI 1956) ("Zbornik"). In *Zbornik*, the rejected claims are related to a process of treating Air Sac Infection in fowl. The representative claim 26 read:

A process of treating Air Sac Infection in fowl which comprises introducing into the intestinal tract of the bird infected with the causative agent of said disease a poultry feed containing approximately 0.1% of a compound selected from the group consisting of para-aminobenzoic acid, water-soluble salts of para-aminobenzoic acid and mixtures thereof, and maintaining said treatment for a period of not less than five days.

*Id.* at 508.

The reference (Marshall) cited by the Examiner disclosed a sulfonamide therapy of malaria in ducks and includes a control run (a comparative test) with a drug diet of 0.1% para-aminobenzoic acid for 18 hours prior to artificial inoculation and six days thereafter. The Examiner held that Marshall substantially met the claims because: "Marshall shows introducing into the intestinal tract of a bird a poultry feed containing approximately 0.1% of a compound selected from the group consisting of para-aminobenzoic acid, water-soluble salts of para-aminobenzoic acid and mixtures thereof and maintaining said treatment for a period of not less than five days." *Id.* The Patent Office Board of Appeals disagreed and stated that "[w]e find no merit in this rejection because in holding that Marshall substantially meets the claims the examiner is obviously giving no weight to the limitation in the claims that the medicated feed is

administered to fowls infected with Air Sac Infection. He thus fails to follow the long line of decisions in which it was held that in evaluating the patentability of process claims the 'material acted upon' must be given weight." *Id.* at 509. The Board pointed out that "Marshall was not concerned with appellants' problem and he failed to even remotely suggest its solution." *Id.* at 508.

Similarly in the case at bar, in rendering the rejection, the Examiner failed to give weight to the "material acted upon," *i.e.*, soya bean plants subject to subsequent attack by phytopathogenic fungi. As discussed above, Asrar *et al.* does not disclose protecting plants subject to subsequent attack by phytopathogenic fungi. Rather, Asrar *et al.* focuses solely on increasing the yield and/or vigor of plants ***in the absence of pest pressure by fungal plant pathogens***. Thus, the material acted upon in Asrar *et al.* is not the same that that of the current claims and the Examiner has failed to give weight to this difference. As such, the Examiner's position on which the obviousness rejection is based, *i.e.*, that "Asrar *et al.* teach treating soybean and seed using fluquinconazole alone and/or in combined [sic] with azoxystrobin which would inherently protect the soybean from soybean rust" is improper in light of the holding of *Zbornik*. Ammerman *et al.* and Suarez-Cervieri *et al.* do not cure this deficiency.

The Examiner acknowledges that Asrar *et al.* does "not expressly teach a method for protecting soy bean plants against rust using prothioconazole" and relies upon Ammerman *et al.* to allegedly cure this deficiency to arrive at the present claims. *See* Office Action at 8. Ammerman *et al.* discloses fungicidal mixtures comprising prothioconazole and at least one further triazole, *e.g.*, fluquinconazole. *See, e.g.*, claim 1 of Ammerman *et al.* However, the use of fungicidal mixtures comprising

prothioconazole and at least one further triazole is not claimed. Thus, the disclosure in Ammerman *et al.* of a combination of prothioconazole and at least one further triazole does not disclose or provide a reason for developing the presently claimed method which uses only fluquinconazole, even when read in combination with Asrar *et al.*

The Examiner then acknowledges that Asrar *et al.* does "not expressly teach a method for protecting soy bean plants against rust using tolyfluanid" and relies upon Suarez-Cervieri *et al.* to allegedly cure this deficiency to arrive at the present claims. See Office Action at 8. However, the use of fungicidal mixtures comprising prothioconazole or tolyfluanid combined with stobilurin-type fungicides is not claimed. Thus, the disclosure in Suarez-Cervieri *et al.* of a combination of prothioconazole or tolyfluanid with stobilurin-type fungicides does not disclose or provide a reason for developing the presently claimed method which uses only fluquinconazole, even when read in combination with Asrar *et al.* and Ammerman *et al.*

At best, the combination of Asrar *et al.*, Ammerman *et al.* and Suarez-Cervieri *et al.* discloses increasing the yield and/or vigor of plants ***in the absence of pest pressure by fungal plant pathogens*** using a combination of prothioconazole and at least one further triazole, or a combination of prothioconazole or tolyfluanid with stobilurin-type fungicides. Thus, even taken together, the combination of Asrar *et al.*, Ammerman *et al.* and Suarez-Cervieri *et al.* does not provide a reason for developing the presently claimed method of protecting soya bean plants subject to subsequent attack by phytopathogenic fungi against soya bean rust by applying fluquinconazole to the seed of said plants. Moreover, the combination of Asrar *et al.*, Ammerman *et al.* and Suarez-Cervieri *et al.* does not provide a reason for developing the presently claimed method of protecting

transgenic soya bean plants subject to subsequent attack by phytopathogenic fungi against soya bean rust by applying fluquinconazole to the seed of said transgenic plants.

As such, the Examiner has not established a *prima facie* case of obviousness of present claims 14 and 16. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

Even if the claimed method were to be considered *prima facie* obvious in view of the cited art, which Applicants assert it is not, as noted at page 4, lines 3-4 of the pending application, it is surprising that applying fluquinconazole to the seed of soya bean plants is effective to protect soya bean plants against soya bean rust because this disease is wind-borne and not soil-borne. For example, Example 1 at page 18 of the pending application indicates that seed treatment with fluquinconazole provides complete disease control for more than 30 days. Moreover, the data provided in the accompanying Declaration Under 37 C.F.R. § 1.132 indicates that applying fluquinconazole to the seed of soya bean plants to protect soya bean plants against soya bean rust provides results comparable to the use of a combination of fungicides. These results are clearly unexpected in view of the requirement in the cited art of (i) absence of pest pressure by fungal plant pathogens; and (ii) combinations of fungicides, and would render moot any showing of *prima facie* obviousness.

### ***Conclusion***

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be

withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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